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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/062,552	04/20/1998	YOSHINOBU SHIRAIWA	35.G2135	3178

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EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 02/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/062,552

Applicant(s)  
Shiraiwa

Examiner  
Mark Wallerson

Art Unit  
2622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 14, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 80-93 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 80-93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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**Part III DETAILED ACTION**

*Notice to Applicant(s)*

1. This action is responsive to the following communications: amendment filed on **12/14/2001**.
2. This application has been reconsidered. Claims 80-93 are pending.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 80-87 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 80, 86, and 87 recite the limitation that "reproduction is not performed for a particular reproducible image.....if the reproduction control section determines that the particular image to be reproduced is not recorded in the recording medium". It is unclear if this particular reproducible image was originally stored on the recording medium in the process described in lines 2-3 of claims 80 and 86, and lines 3-4 of claim 87.

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*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 88, 89, 90, 92, and 93 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al (hereinafter referred to as Anderson) (U. S. 6,177,956).

With respect to claims 88, 90, 92 and 93, Anderson discloses a recording control apparatus for controlling recording of images in a recording medium (64), the apparatus including a storage section (64) for storing a plurality of reproducible images (image files) and a reproduction instruction file (data cell) (figure 8) containing instruction information specifying image data to be reproduced (column 2, line 66 to column 3, line 6), comprising an indication section for indicating deletion of at least one of the images (column 9, lines 52-53), and a control section for controlling deletion of the instruction information (data cell) in the instruction file corresponding to the indicated image (column 9, lines 52-55).

With regard to claim 89, Anderson discloses the recording medium is a detachable memory (column 4, lines 15-17).

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7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claims 88- 93 are rejected under 35 U.S.C. 102(e) as being anticipated by Murata (U. S. 6,111,659).

With respect to claims 88, 90, 92 and 93, Murata discloses a recording control apparatus for controlling recording of images in a recording medium (memory card), the apparatus including a storage section (89) for storing a plurality of reproducible images and a reproduction instruction file (column 6, lines 40-46) containing instruction information specifying image data to be reproduced (print control data) (column 6, lines 40-46), comprising an indication section for indicating deletion of at least one of the images (column 3, lines 36-44), and a control section for controlling deletion of the instruction information in the instruction file corresponding to the indicated image (column 3, lines 36-44).

With regard to claim 89, Murata discloses the recording medium is a detachable memory (column 3, lines 45-50).

With respect to claim 91, Murata discloses a display unit to display the image to be deleted (figure 16).

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***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 91 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson ('956) in view of Anderson (U. S. 6,249,316).

With respect to claim 91, Anderson '956 differs from claim 91 in that he does not clearly disclose a display unit to display the image to be deleted.

Anderson '316 discloses a camera system comprising a sensor (224) for detecting an image and a viewfinder (402) for displaying image(s) (420) to be deleted (column 5, lines 6-33). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Anderson '956 to include a display unit to display the image to be deleted. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Anderson '956 by the teachings of Anderson '316 in order to easily manipulate the images as disclosed by Anderson' '316 in column 1, lines 58-60.

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***Response to Arguments***

11. Applicant's arguments with respect to claims 80-93 have been considered but are moot in view of the new ground(s) of rejection.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two

2121 Crystal Drive

Arlington, VA.

Sixth Floor (Receptionist)

**MARK WALLERSON**  
**PATENT EXAMINER**

MARK WALLERSON